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Appeal No:	2005-0996
Appellant:	Wolfgang Matthes et al.
Application No:	09/848,583
Hearing Room:	A
Hearing Docket:	B
Hearing Date:	Wednesday, June 08, 2005
Hearing Time:	01:00 PM
Location:	Madison Building - East Wing 600 Dulany Street, 9th Floor Alexandria, Virginia 22313-1450

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CONFIRMATION REQUIRED WITHIN TWENTY-ONE DAYS

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CHECK ONE: ( ) HEARING ATTENDANCE CONFIRMED (X) HEARING ATTENDANCE WAIVED → Please consider the enclosed "Arguments in Lieu of Oral Hearing"

Yonghong Chen — Signature of Attorney/Agent/Appellant
5/16/05 — Date
56,150 — Registration No.

Names of other visitors expected to accompany counsel: _____

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I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office on the date shown below.

By: Kyung Chun Date: May 16, 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applic. No.	:	09/848,583 Confirmation No. 8707
Applicant	:	Wolfgang Matthes et al.
Filed	:	May 3, 2001
TC/A.U.	:	3724
Examiner	:	Jason D. Prone
Title:	:	Cutting Device And Method For Trimming
Docket No.	:	A-2820
Customer No.	:	24131
Appeal No.	:	2005-0996

Arguments in Lieu of Oral Hearing

Board of Patent Appeals and Interferences
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

S i r :

In lieu of the Oral Hearing to be held on June 08, 2005,

kindly consider the following remarks:

REMARKS

The following remarks rely upon arguments that have been relied upon in the Brief on Appeal.

The specification is objected to and claims 1-10 and 12-13 are rejected and are under appeal.

Whether or not the specification satisfies the requirements of 37 CFR 1.71.

The Examiner has stated in item 1 on page 2 of the final Office action that it is unclear how the lifting device 2 moves knives 3 against the stationary knife 13.

However, it can be clearly seen from Figs. 1 and 2 of the instant application that the knives 3 are fixedly mounted on the lifting device 2 (see also page 10, lines 8-9 of the specification, noting the word "secured") and thus move together with the lifting device 2. It is therefore clear that the knives 3 can be pressed against the knife 13 during the vertical, non-harmonic oscillatory motion of the lifting device 2. See more detailed discussion below in connection with the rejections under 35 USC 112.

Whether or not claims 1-10 and 12-13 contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, under 35 USC 112, first paragraph.

The Examiner has stated in item 3 on pages 2-3 of the final Office action that it is unclear how the lifting device 2 uses the vertical, non-harmonic oscillatory motion to press knives 3 against the knife 13; it is uncertain if the whole lifting mechanism 2 moves up and down to move the knives 3 towards knife 13 or if the lifting mechanism pivots about the screw and during this pivot the blades are dropped down to cut the work piece. It is uncertain if the knife 13 is a stationary blade to create a shearing cut with knives 3 or blade 13 acts as an anvil and knifes 3 perform a punching/stamping cut.

It is noted that the enablement requirement under 35 U.S.C. § 112, first paragraph, does not require Applicants to disclose everything necessary to practice the invention. The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosure in the patent application coupled with information known in the art without undue experimentation. United States v. Telectronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988). In fact, what is well known is best omitted. *See* In re Buchner,

929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991) ("A patent need not teach, and preferably omits, what is well known in the art.") All that is necessary is that one skilled in the art be able to practice the claimed invention, given the level of knowledge and skill in the art. Further the scope of enablement must only bear a "reasonable correlation" to the scope of the claims. As concerns the breadth of a claim relevant to enablement, the only relevant concern should be whether the scope of enablement provided to one skilled in the art by the disclosure is commensurate with the scope of protection sought by the claims. See MPEP 2164.08.

It is believed that a person skilled in the art could easily understand from the drawings and the disclosure of the invention of the instant application as well as his or her background knowledge how the lifting device 2 uses the vertical, non-harmonic oscillatory motion to press knives 3 against the knife 13. In addition, how the lifting device 2 moves and what type of cutting is taking place are not essential to the invention of the instant application because they are not claimed in the claims. These functions can be achieved by a person skilled in the art in numerous ways without undue experimentation.

Below is a brief review of what is claimed in claim 1 of the instant application:

> *A cutting device for trimming margins of products, comprising a transport device and a first drive for driving the transport device, a stroke device for moving knives for performing the trimming of the margins, and a second drive for driving the stroke device, said first drive and said second drive being embodied as separate, mutually independent drives, and both of said drives being connected to one another via a control system.*

It can be clearly seen from the language of claim 1 that the focus of the invention of the instant application is that the first drive (for driving the transport device) and the second drive (for driving the lifting device) are separate, mutually independent and connected to one another via a control system. The advantages of this kind of configuration are described in detail on page 7, line 22 to page 8, line 9 of the specification. It is also clear from the language of claim 1 that how the lifting device moves and how the cutting is performed are not the concern of the invention of the instant application.

It is, therefore, believed that claims 1-10 and 12-13 do not contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly

connected, to make and/or use the invention, under 35 USC 112, first paragraph.

Whether or not claims 1-10 and 12-13 particularly point out and distinctly claim the subject matter which appellant regards as the invention under 35 U.S.C. § 112, second paragraph.

The Examiner has rejected claims 1-10 and 12-13 under 35 USC 112, second paragraph for the same reasons as listed in connection with the rejection under 35 USC 112, first paragraph.

Claims 1-10 and 12-13 are, therefore, believed to be definite for the same reasons as discussed above in detail.

The Examiner has stated in the Examiner's Answer dated May 18, 2004 that it is unclear how a vertical, non-harmonic oscillatory motion is created and how the knife-lifting device can move when it is fixed to the transmission (see the last sentence of the second paragraph on page 4 of the Examiner's Answer).

First, it is noted that the vertical, non-harmonic oscillatory motion is not recited in the claims. Second, it is noted that the specification does not describe that the knife-lifting device is fixed to the transmission. Rather, it is described

on page 10, lines 19-23 of the specification that the first drive motor 1 achieves the motion of the lifting device 2 through the intermediary of the transmission 22. It is not understood how the Examiner concluded that the knife-lifting device 2 is permanently fixed to the transmission 22, thereby restricting any movement at all (see page 5, lines 13-14 of the Examiner's Answer).

In addition, it is noted that the Examiner did not offer any response to Appellants' argument that the disclosure is only required in commensurate with the scope of protection sought by the claims.

For the above reasons as well as the reasons presented in the Brief on Appeal, the honorable Board is therefore respectfully urged to reverse the objections and rejections of the Primary Examiner.

Respectfully submitted,

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